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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/022,128 | 10/30/2001 | Gregory Wohl | | 1679 |
| 7590 Arthur W. Fisher Suite 316 5553 West Waters Avenue Tamp, FL 33634 | | | EXAMINER VAN BRAMER, JOHN W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/25/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/022,128 | Applicant(s) WOHL, GREGORY | |
| | Examiner John Van Bramer | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 - 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 8, 14 and 17 recite a program per se, which is considered functional descriptive material (see MPEP 2106(IV)(B)(1)(a)). The claims describe the purpose of various computer program functions or modules. The examiner suggests rewriting the claim to include the program stored on a computer readable medium and being executed by a computer processor. Without such a modification, no tangible result can occur. Claims 2-7, 9-13, 15, 16, 18 and 19 suffer from the same deficiency by virtue of their dependency on Claims 1, 8, 14 and 17.

3. Claims 2, 8-13 and 14-16, 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2, 8, 14 and 17 claim "at least one entity" "comprising said sponsor"; "a plurality of targeted customers or potential customers" "comprising said participants"; and a "lost property and promotional function" that "comprises said administrator". The broadest reasonable interpretation of the claimed limitation indicates that the

administrator, sponsor, and participants may be human beings. Additionally claims 3-7, 9-13, 15, 16, 18, and 19 are attempt to claim the sponsor performing actions such as making selections, distributions, creating messages, and communicating message; the candidate performing some function such as visiting, electing, registering; the participant selecting to opt out; and the finder calling. The actions taken by individuals in order to implement the claimed system are non-statutory subject matter. The examiner suggests rewriting the claims to identify the functions of the claimed system instead of the steps the users of the system must perform. MPEP 2105 states that "If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter." Claims, 9-13, 15, 16, 18 and 19 also suffer from the same deficiency as Claims 8, 14 and 17 by virtue of dependency.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent Claims 1, 8, 14 and 17 recite "an automated lost property recovery and marketing program or system". It is

unclear as to whether the applicant is claiming a "program" or a "system". Since the individual parts of the body have been described as a system it is also possible that the applicant considers these two terms to be synonymous. If the terms are expected to be synonymous the examiner is unclear if the applicants intends the claims to be a method or apparatus claim. The examiner suggests rewriting the claims 1, 8, 14 and 17 as eight separate independent claims, with four of the claims directed towards the "automated lost property recovery and marketing program" and the other four directed towards the "automated lost property recovery and marketing system". Claims 2-7, 9-13, 15, 16, 18 and 19 suffer from the same deficiency by virtue of their dependency on Claims 1, 8, 14 and 17. In order to prosecute the claimed invention the examiner has interpreted claims 1-19 as system claims in which the system is able to carryout the claimed functions.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1-19 rejected under 35 U.S.C. 102(e) as being anticipated by Wyssen (PGPUB: US 2001/0053981 A1).

Claims 1-5, 8-11, 14 and 17: Wyssen discloses an automated lost property recovery and marketing program and system comprising:

- a. A database function to create and maintain a database of targeted participants.
(Page 7, Paragraph [0137])
- b. A lost property recovery function to return lost property to a participant. (Page 7, Paragraphs [0050]-[0052])
- c. A promotion and advertising function to selectively communicate promotional information to the defined universe of targeted participants or selected members of the defined universe of targeted participants. (Page 4, Paragraph [0095] and Paragraphs [0099]-[0100])
- d. Usable by a sponsor, participants and an administrator. (Page 4, Paragraph [0095] and Paragraphs [0099]-[0100]; Page 7, Paragraphs [0137]-[0141] and [0150]-[0152])
- e. Wherein candidates are selected and incentives are distributed to said candidates when an election to participate has been made. (Page 4, Paragraphs [0099] – [0100]; and Page 5, Paragraphs [0101]-[0103])
- f. Wherein a unique ID number associated with a tag or label to be attached to a protected item, an E-mail address, and a password are part of the registration process. (Page 4, Paragraph [0093]; and Page 7, Paragraphs [0137]-[0141])

- g. Wherein said database function allows participants to opt out of said sponsor's promotional program. (Page 4, Paragraphs [0099] – [0100]; and Page 5, Paragraphs [0101]-[0103]) (Since the candidates are not required to fill in an online form, the act of not supplying the required information is an inherent election to opt out of the program.)

Claims 6, 12, 15 and 18: Wyssen discloses the automated lost property recovery and marketing system of claims 3, 9, 14, and 17 respectively, wherein said lost property recovery function is capable of

- a. Receiving an ID code that was on the tag or label attached to the found item.
(Page 7, Paragraph [0145])
- b. Comparing the received ID code with registered ID codes in the database. (Page 7, Paragraphs [0150]-[0152])
- c. Matching the received ID code with registered ID codes in the database. (Page 7, Paragraphs [0150]-[0152])
- d. Notifying the participant that the item has been recovered. (Page 7, Paragraphs [0150]-[0152])
- e. Facilitating the recovery of the lost item. (Page 7, Paragraphs [0150]-[0159])

Claims 7, 13, 16 and 19: Wyssen discloses the automated lost property recovery and marketing system of claims 6, 12, 15, and 19 respectively, wherein said promotions and advertising function comprises transmitting the targeted

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promotional message of the sponsor to the designated participants via e-mail.

(Page 4, Paragraph [0097])

Conclusion

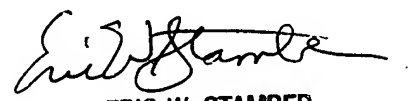
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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